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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)	Confirmation No.: 3399
Andreas Sasse)	
Serial No. 09/600,458)	Group: 2618
Filed: August 14, 2000)	
Title: METHOD FOR TERMINAL)	Examiner: Sujatha R. Sharma
ASSISTED MENU PRESENTATION OF)	
ADDED VALUE SERVICES IN MOBILE)	Attorney Docket No.: RBL0064-02
COMMUNICATION SYSTEMS)	Customer No.: 00832

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief-Patents
Assistant Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits the following Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer ("Answer"), mailed on March 28, 2006 responsive to Appellant's Appeal Brief ("Brief"), filed on December 22, 2005.

ARGUMENT

Responsive to the Examiner's statements in the "Response to Argument" section on pages 7-14 of the Answer, Appellant submits the following reply.

Appellant respectfully submits that Eul '840 in view of Basso et al. '131 and further in view of Sugita '048 do not disclose or suggest all of the steps contained in Claim 1 and, moreover, there is no motivation or incentive for a person of ordinary skill in the art to combine Eul '840, Basso et al. '131, and Sugita '048.

Specifically, Appellant respectfully submits that Eul '840, Basso et al. '131, and Sugita '048, taken together, do not disclose or suggest all of the following steps contained in Claim 1:

- verifying with the object the technical capabilities of the mobile station and the objects automatically adapting to the technical capabilities of the mobile station;
- subsequently selecting and loading into the mobile station an object suitable to the technical capabilities of the mobile station, wherein the technical capabilities of the mobile station are stored in a special database;
- communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node;
- comparing the version number of the available object with a version number of the object available in the mobile station and, if a more up-to-date object is available, loading the more up-to-date object into the mobile station;
- communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

As a preliminary matter, the Examiner repeatedly states (see pages 8, 9, 11 of the Answer):

"In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references."

Appellant respectfully submits that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Appellant has argued repeatedly that the references, *as combined*, do not teach all of the claim limitations of Claim 1. Appellant has not attacked the references individually, but instead has shown which claim limitations are absent from each of the references, such that, even if combined, the references do not teach all the claim limitations of Claim 1.

On page 9 of the Answer, the Examiner states:

"Basso teaches a method of distributing and displaying multimedia data based on both the user preferences and terminal capabilities"

On page 10 of the Answer, the Examiner states:

"Sugita teaches a method of: - receiving a version number in the information packet and comparing the version number of the available object with a version number of the object available in the mobile station and loading the more up-to-date object in the mobile station."

Appellant respectfully submits that mere disclosure of a method of distribution and display of multimedia data based on user preferences and terminal capabilities, or a method of receiving a version number in an information packet and comparing the version number of the available object with the version number of the object available in the mobile station and then loading the more up-to-date object in the mobile station, does not teach or even suggest the claimed steps of verifying with the object the technical capabilities of the mobile station and the objects automatically adapting to the technical capabilities of the mobile station, and subsequently selecting and loading into the mobile station an object suitable to the technical capabilities of the mobile station, wherein the technical capabilities of the mobile station are stored in a special database.

On page 10 of the Answer, the Examiner states:

"Eul discloses a method of: - communicating between a subscriber (MS in Fig. 1) and value added services node"

Appellant respectfully submits that disclosure of mere communication between a subscriber and value added services node does not teach or even suggest the claimed steps of communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node, and communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

Moreover, the Examiner has further failed to establish a *prima facie* case of obviousness because the Examiner has provided no teaching or incentive to combine Eul '840, Basso et al. '131, and Sugita '048.

On pages 12 and 13 of the Answer, the Examiner states:

"the Eul and Basso reference are both directed towards the distribution and presentation of multimedia information. Although the Basso reference does not specifically deal with mobile communication device, it is still directed towards the distribution and presentation of multimedia information in a terminal device according to the capability of the terminal device. Hence, they are in the same field of endeavor and therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Eul to incorporate the method of displaying the multimedia information according to the terminal capability as taught by Basso in order to improve the quality of what is displayed based on both user preferences and terminal capabilities."

In general, Eul '840 and Sugita '048 disclose mobile communication systems. However, Basso et al. '131 has no disclosure or suggestion of a mobile communication system, as indicated by the Examiner (see quote above from pages 12 and 13). Basso et al. '131 instead discloses that display parameters of graphics data are adjusted depending on the display capabilities of a computer terminal. Distribution and presentation of multimedia information in a terminal device according to the capability of the terminal device in no way implies use with a mobile communication system or a terminal assisted menu presentation of value added services in a mobile communication system. Appellant respectfully submits that nowhere does Basso et al. '131 even mention the words "mobile", "communications", or "network." Because Basso et al. '131 does not relate to a mobile communication system, a person of ordinary skill in the art would never choose Basso et al. '131 to combine with Eul '840 and Sugita '048 to solve problems in the mobile communication network or system field. Furthermore, Sugita '048 does not relate, in particular, to methods for controlling value added services in a mobile communication network.

On page 13 of the Answer, the Examiner states, in response to Appellant's argument that the Examiner has failed to show where and how the prior art suggests the desirability of the combination:

"The Examiner would like to draw the appellant's attention to Basso's reference where the invention is directed to improve the quality of what is displayed based on both user preferences and terminal capabilities as taught by Basso ... Therefore at the time of

invention, it would have been obvious to one with ordinary skill in the art to modify Eul with Basso's teachings in order to improve the quality of what is displayed based on both user preferences and terminal capabilities."

Appellant respectfully submits that the Examiner has merely recited an advantage associated with the present invention and still has failed to provide any objective reason to combine the teachings of the references. The Examiner has failed to point out, whether explicitly or implicitly, where or how the references provide an objective reason for combination thereof.

Moreover, statements such as those made by the Examiner that it would be obvious to one of ordinary skill in the art to modify the prior art to meet the claimed invention because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Appellant respectfully submits that the Examiner is utilizing hindsight reasoning and using the present application as a blueprint to piece together the present invention from various pieces found in the prior art.

For the foregoing reasons, Appellant respectfully submits, firstly, that Eul '840 in view of Basso et al. '131 and further in view of Sugita '048 do not disclose or suggest all of the steps contained in Claim 1 and, secondly, there is no motivation or incentive for a person of ordinary skill in the art to combine Eul '840, Basso et al. '131, and Sugita '048. Thus, Appellant respectfully submits that the Examiner's rejection of Claims 1-12 and 15 under 35 U.S.C. § 103(a) over Eul '840, Basso et al. '131, and Sugita '048 is improper.

Appellant respectfully submits that Eul '840 in view of Basso et al. '131 and Sugita '048, and further in view of Michaels et al. '976 do not disclose or suggest all of the steps contained in Claim 8 and, moreover, there is no motivation or incentive for a person of ordinary skill in the art to combine Eul '840, Basso et al. '131, Sugita '048, and Michaels et al. '976.

Michaels et al. '976 discloses downloading data into a subscriber identity module (SIM) card. However, Michaels et al. '976 fails to cure the deficiencies of the combined references, as discussed above. Furthermore, the Examiner has failed to provide a motivation or incentive to combine the disclosure of Michaels et al. '976 with the other three cited references to arrive at the novel method set forth in Claim 8.

On page 14 of the Answer, the Examiner recites various advantages provided by Michaels et al. '976 and further states:

"Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the teachings of Michaels to modified [sp] Eul in order to facilitate the user to access the object/game even if the user has been disconnected form [sp] the mobile phone network."

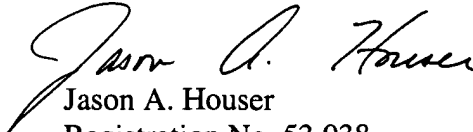
Appellant respectfully submits that the Examiner has merely recited an advantage associated with the present invention and still has failed to provide any objective reason to combine the teachings of the references. The Examiner has failed to point out, whether explicitly or implicitly, where or how the references provide an objective reason for combination thereof.

For the foregoing reasons and for the reasons advanced above with respect to Claim 1, Appellant respectfully submits that Eul '840 in view of Basso et al. '131 and Sugita '048, and further in view of Michaels et al. '976 do not disclose or suggest all of the steps contained in Claim 8 and, moreover, there is no motivation or incentive for a person of ordinary skill in the art to combine Eul '840, Basso et al. '131, Sugita '048, and Michaels et al. '976. Thus, Appellant respectfully submits that the Examiner's rejection of Claim 8 under 35 U.S.C. § 103(a) over Eul '840, Basso et al. '131, Sugita '048, and Michaels et al. '976 is improper.

PATENT

In the event Appellant has overlooked the need for an extension of time or payment of fee, Appellant hereby petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

Respectfully submitted,


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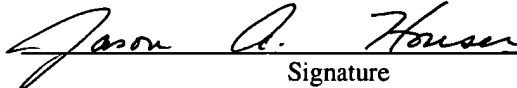
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Name of Registered Representative


Signature

May 25, 2006

Date